



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,549	04/01/2002	Michio Kubota	KUBOTA=9	3265

1444 7590 11/14/2005
BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

EXAMINER

RAO, MANJUNATH N

ART UNIT PAPER NUMBER

1652

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,549

Applicant(s)

KUBOTA ET AL.

Examiner

Manjunath N. Rao, Ph.D.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,8-15 and 46-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,3,8-15 and 46-53 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 3, 8-15, 46-47, 48-51 and new claims 52-53 are currently pending and are present for examination.

Applicants' amendments and arguments filed on 3-5-05, have been fully considered and are deemed to be persuasive to overcome the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

It is noted that applicants have made elaborate amendments to the claims in such a way that Examiner has to initiate a new search since all the previous searches are rendered meaningless in view of the new amendments. Applicants do not show support for these amendments in the specification and a quick perusal of the specification did not provide the Examiner the support for the amendments. Furthermore, Examiner has now realized that applicants indeed have four different inventions bundled in one application which imposes a serious search burden on the Examiner. Hence Examiner has restricted the application such that he can examine one invention at a time.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 47, 51, drawn to α -isomaltosylglucosaccharide forming enzyme from *B.globisporus* C9 having the characteristics listed in claim 1.
- II. Claims 8-11 drawn to method of producing an α -isomaltosylglucosaccharide forming enzyme.

Art Unit: 1652

- III. Claims 12-15 drawn to method of producing an α -isomaltosylglucosaccharide forming enzyme.
- IV. Claim 46 drawn to a biologically pure culture containing α -isomaltosylglucosaccharide forming enzyme.
- V. Claims 48, 50, 51, drawn to α -isomaltosylglucosaccharide forming enzyme from *Arthrobacter.globiformis* A19 having the characteristics listed in claim 48.
- VI. Claims 52, drawn to α -isomaltosylglucosaccharide forming enzyme from *B.globisporus* C11 having the characteristics listed in claim 52.
- VII. Claims 53, drawn to α -isomaltosylglucosaccharide forming enzyme from *B.globisporus* N75 having the characteristics listed in claim 53.

The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: These inventions are drawn to different enzymes from different sources having different structural properties. Pursuant to 37 C.F.R. 1.475 (d), the ISA/US considers that where multiple products and processes are claimed, the main invention shall consist of the first invention of the category first mentioned in the claims and the first recited invention of each of the other categories related thereto. Accordingly, the main invention (Group I) comprises the first-recited product, α -isomaltosylglucosaccharide forming enzyme from *B.globisporus* C9 having the characteristics listed in claim 1. Further pursuant to 37 C.F.R. 1.475 (d), the ISA/US considers that any feature which the subsequently recited products and methods share with the main invention does not constitute a special technical feature within the meaning of PCT Rule 13.2 and that each of such products and methods accordingly defines a separate invention.

Art Unit: 1652

Applicant is advised that the reply to this requirement to be complete **must include an election of the** invention to be examined even though the requirement be traversed (37 CFR 1.143).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II-VII, restriction for examination purposes as indicated is proper.

In the instant case, even though the inventions are all drawn to α -isomaltosyl gluco-saccharide forming enzyme they are deemed patentably distinct since they have different characteristics and different sources and there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the above inventions (species) to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Sequence Compliance

It is noted that applicant has introduced new SEQ ID NO in the specification. However, the SEQ ID NO provided for the sequences in the specification does not match with the SEQ ID in the original sequence listing. For example SEQ ID NO:11 (PN21) in the new specification amendment comprises only 6 amino acids. However, the original sequence listing filed on 4-1-2002 shows SEQ ID NO:11 as comprising 9 entirely different amino acids. Examiner requests clarification and reminds applicants that if the SEQ ID NO provided for the sequences in the specification are new they need to file a new paper copy and electronic copy of sequence listing. They also need to show support for the amendments by way of page number and line number in the specification.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and for After Final communications.

Art Unit: 1652

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

A handwritten signature in black ink, appearing to read 'Manjunath N. Rao', with a stylized flourish at the end.

Manjunath N. Rao, Ph.D.
Primary Examiner
Art Unit 1652

October 28, 2005